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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,061	12/02/2003	Scott Jacobs	130136	9480

7590 08/11/2004

Law Offices of John S. Munday  
PO BOX 423  
Isanti, MN 55040

EXAMINER

NGUYEN, CAMTU TRAN

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/727,061	Applicant(s) JACOBS, SCOTT	
	Examiner Camtu T. Nguyen	Art Unit 3743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 7-10, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adell (U.S. Patent No. 5,406,963) in view of Tucker (U.S. Patent No. 6,045,359). Adell discloses in Figures 1-5 a mouthguard (10) which generally is a U-shaped for fitting into the mouth and comprising wall (14) and trough (16, 18) on opposite sides. The mouthguard (10) includes series of holes (20) extending through wall (14). It is on the mouthguard (10) that a liner (12) is molded directly thereon by injection molding process. The liner (12) material is Elvas (ethylene/vinyl acetate copolymer). Adells' mouthguard does not have a tab extending out therefrom, as recited. Tucker discloses in Figures 1-5 a dental impression tray comprising elements as recited in these claims including an integral handle (11). Therefore it would have been obvious to one skilled in the art to modify the Adell's mouthguard to include an integral handle as suggested by Tucker for the purpose of providing proper placement when inserting the device into the patient's mouth.

Claims 6 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adell (U.S. Patent No. 5,406,963), as modified above, and further in view of Kagekata et al (U.S. Patent No. 6,397,848). Adell, as modified above, discloses in Figures 1-5 a mouthguard

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comprising elements as recited in these claims except for the gel is of the material, as recited.

Kagekata et al teaches a mouthguard composition containing styrene block copolymer.

Therefore it would have been obvious to one of ordinary skill in the art to apply the composition as taught by Kagakata as such would offer high durability, impact absorption and superior in tear strength.

Claims 5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adell (U.S. Patent No. 5,406,963), as modified above, and further in view of Wagner et al (U.S. Patent No. 4,776,792). Adell, as modified above, discloses in Figures 1-5 a mouthguard comprising elements as recited in these claims except for the gel is of the material, as recited. Wagner et al discloses in Figures 1-6 a composite arch-shaped tray comprising elements set forth in these claims including outer flange (2), inner flange (3) projecting in the same direction from opposite edges of the tray bottom (4). The bottom of the tray (4) having a plurality of apertures (6) for engaging the thermoplastic material filler pad (5) thereon. Therefore it would have been obvious to one skilled in the art to apply the filler pad taught by Wagner et al in Adell's moughuard as such would provide strength to remain attached to the mouthguard's bottom.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Camtu T. Nguyen whose telephone number is 703-305-0537.

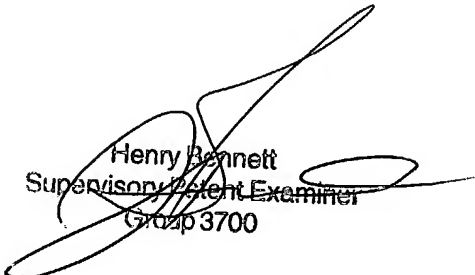
The examiner can normally be reached on (M-F) 8:30-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A. Bennett can be reached on 703-308-0101. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Camtu Nguyen  
August 8, 2004



Henry Bennett  
Supervisory Patent Examiner  
Group 3700